PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: NOAM LIVNAT HON TAT LAU	Conf. No. 2284 Examiner: Avi M. Gold
Serial No.: 10/058,494	Group Art Unit: 2157
Filed: January 24, 2002	Att'y Docket: 2000.129000/TT5979
For: INSTALLING COMMUNICATION PROTOCOL IN A HANDHELD DEVICE	Customer No.: 23720

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit this Appeal Brief to the Board of Patent Appeals and Interferences in response to the final Office Action dated August 23, 2007. A Notice of Appeal was filed on September 11, 2007 and so this Appeal Brief is believed to be timely filed.

The Commissioner is authorized to deduct the fee for filing this Appeal Brief ($500) from **Williams, Morgan & Amerson's P.C. Deposit Account 50-0786/2000.129000.**

I. REAL PARTY IN INTEREST

The present application is owned by Advanced Micro Devices, Inc. The assignment of the present application to Advanced Micro Devices, Inc., is recorded at Reel 012543, Frame 0429.

II. RELATED APPEALS AND INTERFERENCES

Applicants are not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF THE CLAIMS

Claims 1-7 and 9-10 are pending in the present application. Claims 1-7 and 9-10 are the subjects of the current appeal. Claims 1-7 and 9-10 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Ishii (U.S. Patent No. 6,594,505) in view of Farazmandnia (U.S. Patent No. 6,625,472).

IV. STATUS OF AMENDMENTS

There were no amendments after the final rejections.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Handheld devices such as personal digital assistants, digital cameras, or cellular phones, typically contain microprocessors or application-specific integrated circuits for running software or microcode. Vendors may from time to time provide these handheld devices with new types of hardware. Software upgrades may be necessary for the handheld device to interact properly with

the add-on the module. However, these software upgrades are not typically provided as part of the hardware add-on. Users may therefore avoid performing the upgrade due to a perceived lack of technical expertise or worries that errors in the upgrade process may damage the product and render it useless. See Patent Application, page 1, ll. 5-23.

At least in part to address these drawbacks in conventional practice, independent claims 1, 5, and 7 set forth, among other things, physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols. The plurality of communication protocols includes the first communication protocol and a second communication protocol. For example, an expansion card that supports multiple protocols (*e.g.*, MMC and SDIO) may be physically inserted into an expansion slot of a personal data assistant. See Patent Application, page 6, ll. 20-25. Independent claims 1 and 7 also set forth establishing communication between the first and second devices using the first communication protocol, transferring the second communication protocol from the second device to the first device, and installing the second communication protocol on the first device. The first device then switches to the second communication protocol for further communication. In independent claim 5, the communication is established using the first protocol in response to determining that the second communication protocol is not installed on the second device and selecting the first communication protocol from the plurality of communication protocols. See Patent Application, page 7, ll. 1-19.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants respectfully request that the Board review and overturn the single rejection present in this case. The following issue is presented on appeal in this case:

(A) Whether claims 1-7 and 9-10 are obvious over Ishii in view of Farazmandnia.

VII. ARGUMENT

A. Legal Standards

A finding of obviousness under 35 U.S.C. § 103 requires a determination of the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. John Deere Co.*, 148 USPQ 459 (U.S. S.Ct. 1966).

To determine whether the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made, one should determine whether the prior art reference (or references when combined) teach or suggest all the claim limitations. Furthermore, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. The required reason may be provided by some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Thus, the absence of a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings may be evidence that the claims are not obvious. Moreover, there should be a reasonable expectation of

success on the part of a person of ordinary skill in the art. Teaching away by the prior art may constitute *prima facie* evidence that the claimed invention is not obvious.

B. Claims 1-7 and 9-10 are not obvious over Ishii in view of Farazmandnia.

Ishii describes a mobile radio telephone 3 that may download communication protocol software from a base station 1 over a wireless communication link or air interface. See Ishii, col. 5, ll. 1-6 and Figure 1. However, the mobile radio telephone 3 is not physically attached to the base station 1. Thus, as admitted by the Examiner, Ishii fails to teach or suggest physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, as set forth in independent claims 1, 5, and 7.

Farazmandnia describes a Universal Serial Bus (USB) connection between a cellular telephone 3 and a personal computing device 1. The cellular telephone 3 may also communicate with a base station 5 over a wireless link 4 so that a communication link can be formed from the personal computing device 1 to the base station 5. See Farazmandnia, col. 4, ll. 4-32 and Figures 1 and 2. In the Final Office Action, the Examiner argues that a person of ordinary skill in the art would be motivated (in view of Farazmandnia) to modify Ishii to physically attach devices because this would allow for a direct connection between the mobile radio telephone 3 and the base station 1.

Applicants respectfully submit that modifying Ishii in the manner suggested by the Examiner would require that the mobile radio telephone 3 described by Ishii be modified so that it can be physically connected to the base station 1, *e.g.*, using the USB connection described in Farazmandnia. Applicants also respectfully submit that a person of ordinary skill in the art would *not* be motivated to modify the prior art to physically connect a mobile radio telephone to

a base station in the manner suggested by the Examiner. To the contrary, persons of ordinary skill in the art of wireless communication will appreciate that (by definition) mobile phones are designed to communicate with base stations over an air interface and *not* via a wired connection. Furthermore, the manner in which mobile phones and base stations are used and deployed strongly encourages persons of ordinary skill in the art to use the air interface for communication between the mobile phone and the base station. For example, base stations are typically located in remote locations such as at the tops of towers or buildings that would be very difficult to reach in the event that a person wanted to establish a wired connection between a mobile phone and a base station. Consequently, base stations are not configured for wired connections to mobile units.

Applicants further submit that the references cited by the Examiner also teach that communication between mobile phones and base stations takes place over the air interface. For example, Ishii teaches that mobile telephones located in a communication area associated with either a first or second base station may download first or second mobile radio telephone communication protocol software from the first or second base stations depending on which base station is serving the communication area. See Ishii, col. 4, ll. 27-51. When taken in context, Applicants submit that the description in Ishii is describing downloading the mobile radio telephone communication protocol software over an air interface. Consequently, Applicants respectfully submit that Ishii teaches away from physically connecting a mobile telephone to a base station for any purpose and, in particular, for the purpose of downloading communication protocol software.

Farazmandnia also teaches that cellular telephones communicate with base stations over an air interface. As noted by the Examiner, Farazmandnia teaches that a USB connection may be

used to support communication between a cellular telephone and a personal computer. However, the USB connection described by Farazmandnia is used to connect the personal computer to the cellular telephone so that the personal computer can utilize the air interface established between the cellular telephone and the base station. Thus, Applicants respectfully submit that Farazmandnia fails to provide any teaching that would lead a person of ordinary skill in the art to connect a cellular telephone to a base station in the manner suggested by the Examiner. To the contrary, Applicants respectfully submit that Farazmandnia teaches away from using the USB connection described by Farazmandnia to couple a cellular telephone to a base station.

For at least the aforementioned reasons, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 1-7 and 9-10 are obvious over Ishii in view of Farazmandnia. Applicants request that the Examiner's rejections of claims 1-7 and 9-10 under 35 U.S.C. § 103(a) be REVERSED.

VIII. CLAIMS APPENDIX

The claims that are the subject of the present appeal – claims 1-7 and 9-10 – are set forth in the attached "Claims Appendix."

IX. EVIDENCE APPENDIX

There is no separate Evidence Appendix for this appeal.

X. RELATED PROCEEDINGS APPENDIX

There is no Related Proceedings Appendix for this appeal.

XI. CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application, claims 1-7 and 9-10, over the prior art of record. The undersigned may be contacted at (713) 934-4052 with respect to any questions, comments or suggestions relating to this appeal.

Respectfully submitted,

Date: September 24, 2007

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AGENT FOR APPLICANTS

CLAIMS APPENDIX

1. (Original) A method for delivering a communication protocol to an electronic device, comprising:

physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, the plurality of communication protocols including the first communication protocol and a second communication protocol;

establishing communication between the first and second devices using the first communication protocol;

transferring the second communication protocol from the second device to the first device;

installing the second communication protocol on the first device; and

switching to the second communication protocol for further communication.

2. (Original) The method of claim 1 wherein the first and second communication protocol are software communication protocols.

3. (Original) The method of claim 1 wherein the first and second electronic devices are handheld devices.

4. (Original) The method of claim 1 wherein the established communication is point-to-point communication.

5. (Original) A method for exchanging data between electronic devices, comprising:

physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, the plurality of communication protocols including the first communication protocol and a second communication protocol;

determining that the second communication protocol is not installed on the second device;

based on this determination, selecting the first communication protocol from the plurality of communication protocols; and

establishing communication between the first and second devices using the first communication protocol.

6. (Original) The method of claim 5 further comprising:

transferring the second communication protocol from the second device to the first device;

installing the second communication protocol on the first device; and

switching to the second communication protocol for further communication.

7. (Previously Presented) An apparatus for delivering data to a handheld electronic device, the apparatus comprising:

an electrical connector physically coupling the apparatus to the handheld device;

non-volatile storage for storing a plurality of communication protocols including a first communication protocol and a second communication protocol; and

a processor configured to:

establish communication with the handheld device using the first communication protocol via the electrical connector;

transfer the second communication protocol to the handheld device via the electrical connector;

install the second communication protocol on the handheld device; and

switch to the second communication protocol for further communication with the handheld device.

8. (Canceled)

9. (Original) The apparatus of claim 7 wherein the first and second communication protocol are software communication protocols.

10. (Original) The apparatus of claim 7 wherein the established communication is point-to-point communication.